

REMARKS

Claims 1, 36, 55, 56, 59, 77, 99 and 101-116 have been amended. Claims 1-116 are pending in the application. Reconsideration is respectfully requested in light of the following remarks.

Section 101 Rejection:

The Examiner rejected claims 101-116 under 35 U.S.C. § 101 as being directed to software. Applicants respectfully traverse this rejection. However, to expedite prosecution, claims 101-106 have been amended. Withdrawal of the § 101 rejection is respectfully requested.

Double Patenting Rejection:

The Examiner rejected claims 1-116 under the judiciary created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Pat. No.: 7,065,579. Applicants respectfully traverse this rejection on the grounds that the Examiner has not stated a proper *prima facie* rejection.

According to MPEP 804.II.B.1, “the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection.” This section of the MPEP also states that the same “factual inquiries ... that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are employed when making an obviousness-type double patenting analysis.” MPEP 804.II.B.1 also states that the Examiner should list the differences between **each** rejected claim and the claims of the other patent/application, and for **each** difference the Examiner should give the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim is an obvious variation of the invention defined in a claim of the other patent/application.

The Examiner argues that the instant application and the ‘579 patent “are claiming common subject matter”, but does not list the actual differences between each rejected claim and the claims of the ‘579 patent. Instead, the Examiner only discusses claim 1 “as an exemplary claim”, stating, “the applications are claiming common subject matter.” The Examiner only attempts to discuss one difference between Applicants’ claims and the claims of the ‘579 patent. Specifically, the Examiner admits that “[t]he claims of the ‘579 patent do not specifically state service layer as described in the claims of the instant application.” The Examiner does not address, or even attempt to list, the actual differences between the “mechanism for accessing services” of the ‘579 patent and the “service layer” of Applicants’ claims. Thus, the Examiner has clearly failed to meet his burden to address *each difference of each rejected claim* of the present application compared to the claims of the ‘579 patent.

The Examiner then asserts that “it would have been obvious to a person skill[ed] in the art to recognize that the mechanism for accessing services of the ‘579 patent is ... similar in functionality to the service layer of the instant application because it would enable peer nodes to access ... resources or services of other nodes within a peer group.” Thus, the Examiner has not stated a valid reason why one would consider Applicants’ claim 1 an obvious variation of the claims of the ‘579 patent. Instead, the Examiner has merely provided his own opinion, without any supporting evidence, that one would recognize that functionality of the ‘579 patent *is similar* to the “service layer” of Applicants’ claims. Furthermore, simply stating that some mechanism of the ‘579 patent would be recognized as similar to the “service layer” of Applicants’ claims is not a valid reason why a person of ordinary skill in the art would conclude that the invention defined in each rejected claim is an obvious variation of the invention defined in a claim of the other patent/application.

Nor has the Examiner specifically addressed **each difference of each rejected claim** of the present application compared to the claims of the other applications. Instead, the Examiner improperly lumped all the claims together and did not address each specific difference. For instance, the Examiner fails to address the differences in scope

between Applicants' various independent claims. Instead, the Examiner merely states that claims 36, 53, 55-59, 73, 75-77, 97, 99-101 and 114-116 "are also directed to the same subject matter recited in claim 1." Thus, the Examiner has not addressed the differences between the rejected claims 36, 53, 55-59, 73, 75-77, 97, 99-101 and 114-116 and the claims of the 7,065,579 patent.

Additionally, the Examiner rejects dependent claims 2-35, 37-52, 60-72, 74, 78-96, 98 and 102-112 because "they depend from rejected claims." The Examiner does not attempt to list any differences between these claims and the claims of the '579 patent. Nor does the Examiner attempt to give reasons why one of ordinary skill would conclude that these claims are obvious variations of the claims of the '579 patent.

The Examiner clearly has not met the requirements stated in MPEP 804.II.B.1 to establish a *prima facie* obviousness-type double patenting rejection. Accordingly, Applicants respectfully request removal of the double patenting rejection of claims 1-116.

Section 102(e) Rejection:

The Examiner rejected claims 1-3, 6, 8-13, 15, 17-22, 25-30, 32-38, 40-42, 44, 45, 47-60, 62, 63, 65-80, 82-84, 86, 87, 89, 90, 92-101, 103, 104, 106-108 and 110-116 as being anticipated by Weisman et al. (U.S. Publication 2002/0112058). Applicants respectfully traverse this rejection for at least the reasons below.

Applicants note that the rejection is improper because the Examiner has not shown that Weisman qualifies as a prior art reference. The Examiner has the burden of proof to produce the factual basis for the rejection. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968). Since the Examiner has not proven that Weisman qualifies as a prior art reference, the Examiner has not met this burden of proof and the rejection is improper. More specifically, the Weisman publication was filed on June 1, 2001, after Applicants' priority date of April 24, 2001. Weisman does claim the benefit of a provisional application filed December, 1, 2000. However, the

December, 1, 2000 filing date can only be used as Weisman's 35 U.S.C. § 102(e) prior art date for the subject matter that is common to both the Weisman publication and the provisional application. Since it is common practice for a later filed utility application to include more or different subject matter than its earlier provisional application, it is unclear whether the material in Weisman relied upon by the Examiner was actually present in Weisman's provisional application. If fact, a review of Weisman's provisional application reveals that it varies considerable from Weisman's published utility application. Unless the Examiner can prove that the subject matter on which the Examiner is relying on to reject Applicants' claims is also entirely present in Weisman's provisional application, the rejection is improper. *See, In re Wertheim*, 209 USPQ 554 (CCPA 1981).

For example, Weisman's provisional application appears to be a reference manual to using the UPnP API. However, Weisman's provisional application does not appear to disclose or mention, anything regarding using the UPnP API for peer-to-peer networking purposes, as relied on by the Examiner in the rejection of Applicants' claims.

Moreover, the Weisman publication is not entitled to the June 30, 1999 date as a section 102(e) prior art date unless at least one claim of the Weisman published application is supported (under 35 U.S.C. § 112) in the provisional application. Under 35 U.S.C. 119(e)(1), an application is not entitled to a provisional application's filing date as a prior art date unless at least one claim of the published utility application is supported (per 35 U.S.C. § 112) in the provisional application. Weisman's provisional application does not appear to fully support the claims of Weisman's utility application. For example, Weisman's provisional application does not appear to support peer networking protocol limitations of claim 1 in Weisman's utility application.

The rejection is improper unless the Examiner can show that Weisman's published application has the necessary claim support in the provisional application to be entitled to the provisional application's filing date as its § 102(e) prior art date. *See also* M.P.E.P. § 2136.03(IV). Since the Examiner has not provided the necessary evidence to

show that the Weisman publication is prior art to the present application, the current rejection is improper.

Furthermore, regarding claim 1, Weisman fails to disclose wherein at least one of the one or more peer-to-peer platform protocols is configured to be used by a peer node to discover other peer nodes that are members of specified peer groups.

Weisman teaches a device hosting framework that provides hosting for software-implemented logical devices on a computer to expose their services as controlled devices per a peer networking protocol. Weisman's device hosting framework encapsulates discovery, description and control protocol operations so that developers do not have to individually implement the peer networking protocol in every logical device.

However, Weisman does not describe or teach anything regarding a peer-to-peer platform protocol configured to be used to discover peer nodes that are members of specified peer groups. Instead, Weisman teaches a discover protocol that allows hosted devices to broadcast a service advertisement that describes a service provided by the hosted device. (see, paragraphs [0045], [0839-0844], and [0849]). Nowhere does Weisman describe a peer-to-peer platform protocol that can be used to discover peer nodes that are members of particular peer groups, as in claim 1.

Applicants respectfully remind the Examiner that anticipation requires the presence in a single prior art reference disclosure of each and every limitation of the claimed invention, arranged as in the claim. M.P.E.P 2131; *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). The **identical** invention must be shown in as complete detail as is contained in the claims. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). As discussed above, Weisman fails to disclose wherein at least one of the one or more peer-to-peer platform protocols is configured to be used by a peer node to discover other peer nodes that are members of specified peer groups. Therefore, Weisman cannot be said to anticipate claim 1.

Thus, the rejection of claim 1 is not supported by the cited art and removal thereof is respectfully requested. Similar remarks also apply to claims 36, 59, 77 and 101.

Regarding claim 53, the Examiner has failed to even attempt to provide a proper *prima facie* rejection of claim 53. The Examiner merely asserts that claim 53 does “not define or teach any new limitations other than [the] above claims 1-3, 6, 8-13, 15, 17-22, 25-30, and 32-35. However, the Examiner is improperly ignoring both the specific language and the particular limitations of claim 53 that are not recited in any of claims 1-3, 6, 8-13, 15, 17-22, 25-30, and 32-35. Thus, the Examiner has clearly failed to provide a proper *prima facie* rejection of claim 53. As noted below, the Examiner has also failed to provide a proper *prima facie* rejection of claims 55, 56, 57, 58, 73, 75, 76, 97, 99, 100, 114, 115 and 116.

In further regard to claim 53, Weisman fails to disclose a peer node configured to move from the network location to a different network location and where the peer node is executable to discover and access a *different instance of the service on a different one of the plurality of peer nodes*. Claim 53 recites, in part, a peer node discovering and accessing an instance of a service on one of the peer nodes, moving to a different network location and discovering and accessing a *different instance of the service* on a different one of the peer nodes. The Examiner, as noted above, has not cited any portion of Weisman regarding these limitations of claim 53. Moreover, Weisman does not mention anything regarding a node moving to a different network location discovering and accessing a *different instance of the service on a different one of the plurality of peer nodes*.

Weisman describes the use of a device hosting framework providing hosting for software-implemented logical devices, but does not describe a peer node moving to a different network location. Nor does Weisman disclose a peer node discovering and accessing a different instance of the service on a different peer node.

As discussed above regarding claim 1, anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). The **identical** invention must be shown in as complete detail as is contained in the claims. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). As discussed above, Weisman clearly fails to anticipate claim 53. Thus, the rejection is not supported by the cited art and removal thereof is respectfully requested. Similar remarks also apply to claims 73, 97 and 116.

Regarding claim 55, Weisman fails to disclose that the different one of the peer nodes is operable to provide a unique identifier to the instance of the service hosted by the particular peer node, where the unique identifier distinguishes the different one of the plurality of peer nodes from the other peer nodes on the network, move to a different network location, and where the instance of the service is operable to recognize the different one of the peer nodes using the unique identifier and to route information provided by the service to the different peer node at the different network location. Thus, claim 55 recites, part, peer nodes providing access to an instance of service to a different one of the peer nodes. The different peer node is operable to *provide a unique identifier* to the instance of the service and *move to a different network location*. The instance of the service is operable to recognize the different peer node *using the unique identifier* and to route information to the different peer node at the different network address. As with claim 53, discussed above, the Examiner does not cite any portion of Weisman regarding these limitations of claim 55.

However, Weisman does not disclose anything regarding a peer node moving to a different network location. Nor does Weisman disclose anything regarding an instance of a service using a unique identifier provided by a peer node to recognize the peer node at a different network location and to route information to the different peer node at the different network address. The Examiner, regarding claim 35, relies on Weisman's UDN as a unique identifier. However, Weisman fails to disclose an instance of a service using the UDN to recognize a device that has moved to a different network location. In fact, as

noted above, Weisman fails to disclose a node or device *moving to a different network location*.

Additionally, Weisman teaches, “[t]he foundation for UPnP networking is IP addressing” and that each device obtains an IP address either from a DHCP server or via an AutoIP process that “defines how a device intelligently chooses an IP address from a set of reserved addresses ...” (paragraph [0812]). Weisman clearly teaches the use of IP addresses which clearly cannot be used by an instance of the service to *recognize a peer node at a different network location* to which the peer node has moved, as recited in claim 55. Thus, Weisman *teaches away* from an instance of a service using a unique identifier provided by a peer node to recognize that peer node at a different network address to which the peer node has moved.

Thus, for at least the reasons above, the rejection of claim 55 is not supported by the cited art and removal thereof is respectfully requested. Similar remarks also apply to claims 56, 75, 99 and 115.

In regard to claim 57, Weisman fails to disclose a peer node discovering and accessing an instance of a content on one of the peer nodes, moving to a different network location and discovering and accessing a different instance of the content on a different one of the peer nodes. As noted above, Weisman fails to disclose anything a device or node moving to a different network location. Please refer to the discussion of claims 53 and 55 above for a more detailed discussion of Weisman’s failure to teach anything regarding a device or node moving to a different network location.

Additionally in regard to claim 57, Weisman fails to disclose a peer node discovering and accessing an instance of a content on one peer node, moving to a different network location and discovering and accessing a *different instance of content on a different peer node*. The Examiner has not cited any portion of Weisman that mention anything regarding a peer node discovering and accessing a *different*

instance of content on a different peer node after moving to a different network location, as recited in claim 57.

Thus, for at least the reasons presented above, the rejection of claim 57 is not supported by the cited art and removal thereof is respectfully requested. Similar remarks also apply to claims 58, 76, 100 and 114.

Section 103(a) Rejection:

The Examiner rejected claims 4, 7, 14, 16, 23, 24, 31, 39, 43, 46, 61, 64, 81, 85, 88, 91, 102, 105 and 109 under 35 U.S.C. § 103(a) as being unpatentable over Weisman in view of Ferguson et al. (U.S. Patent 6,490,618) (hereinafter “Ferguson”). Applicants respectfully traverse the rejection of claims 4, 7, 14, 16, 23, 24, 31, 39, 43, 46, 61, 64, 81, 85, 88, 91, 102, 105 and 109 for at least the reasons presented above regarding their respective independent claims.

Applicants also assert, regarding both the § 102 and § 103 rejections, that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the rejections have been shown to be unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time.

CONCLUSION

Applicants submit the application is in condition for allowance, and prompt notice to that effect is respectfully requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-06800/RCK.

Respectfully submitted,

/Robert C. Kowert/
Robert C. Kowert, Reg. #39,255
Attorney for Applicants

Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C.
P.O. Box 398
Austin, TX 78767-0398
Phone: (512) 853-8850

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